

U.S. Serial No. 10/624,213
Filed: July 22, 2003
Response to Office Action

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REMARKS

I. Introduction

The application has been carefully reviewed in light of the Office Action dated December 6, 2006. This communication is believed to be a full and complete response to that Office Action. Claims 1-5, 8, 10, 12 and 13 were pending in the present application prior to entry of the present amendments. By the present Office Action claims 1-5, 8, 10, 12 and 13 have been rejected.

By the present amendment, claims 1, 5, 10, 12 and 13 have been amended. No new claims have been added. Claim 8 has been canceled. Claims 2-4, also remain in the application, and upon entry of the present amendment, claims 1-5, 10, 12 and 13 are present.

Support for these amendments can be found in the original specification, and thus, no new matter has been added. Applicant reserves the right to pursue all original claims in this or other patent applications. Reconsideration and reexamination of the present application is respectfully requested in light of the foregoing amendments and in view of the following remarks, which establish that the pending claims are directed to allowable subject matter.

II. CLAIM REJECTIONS

Under 35 U.S.C. § 102

Claim 13 was rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Application Publication No. 2002/0094811 to *Bright* (hereinafter "*Bright*"). Applicant respectfully traverses the rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." See MPEP § 2131;

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Verdegaal Bros. v. Union oil Co. of Calif., 814 F. 2d 628, 631 (Fed. Cir. 1987). *Bright* fails to satisfy this requirement because it does not disclose all of the elements of the amended claim 13.

Amended Claim 13 is reproduced below.

Claim 13. A method, comprising the steps of:

receiving a message and a termination request at a message service center, the message terminating at a dual mode GSM-ANSI Interoperability team (GAIT) communications device;

determining a Terminal Type of the GAIT communications device;

validating the GAIT communications device by the message service center;

if a subscription profile associated with the GAIT communications device has been re-provisioned in the message service center and the Terminal Type of the GAIT communications device is Global System for Mobile communications, then routing the message and the termination request using a GSM Home Location Register operating in a Global System for Mobile communications network, then routing of the message using a signal transfer point performing a global title translation for a Mobile Station Integration Services Digital Network number associated with the GAIT communications device, the message and termination request being processed by the GSM Home Location Register for termination at the GAIT communications device; and

if the subscription profile associated with the GAIT communications device remains provisioned in the message service center and the Terminal Type of GAIT communications device is GSM-ANSI Interoperability Team, then routing the message and the termination request using a TDMA Home Location Register in a Time Division Multiple Access communications network, the routing of the message using a signal transfer point performing a global title translation for a Mobile Subscriber Identification Number associated with the GAIT

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communications device, the message and termination request being processed by the TDMA Home Location Register for termination at the GAIT communications device.

Applicant respectfully submits that *Bright* does not disclose explicitly or inherently, at least the elements of amended Claim 13 highlighted above in bold italics. In this regard, *Bright* does not teach or include routing the message and the termination request using a GSM Home Location Register operating in a Global System for Mobile communications network, if a subscription profile associated with the GAIT communications device has been re-provisioned in the message service center and the Terminal Type of the GAIT communications device is Global System for Mobile communications, as recited in amended Claim 13. Claim 13 also claims routing of the message using a signal transfer point performing the global title translation for a Mobile Subscriber Identification Number associated with the GAIT communications device if the subscription profile associated with the GAIT communications device remains provisioned in the message service center with the Terminal Type of GAIT communications device is GSM-ANSI Interoperability Team, then routing the message and the termination request using a TDMA Home Location Register in a Time Division Multiple Access communications network. Neither are these elements taught or included in *Bright*.

Support for the amendments to Claim 13 can be found in the original specification. Support can be found, for example, in Figures 6 and 7, and paragraphs [0030] – [0033]. The amendments do not introduce new matter.

Respectfully, the portions of *Bright* cited in the Office Action merely discuss routing the SMS messages across differing network types using a GPRS interoperability function based on various states of registration of the mobile station. The cited sections, however, do not disclose,

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teach, or otherwise include the conditional message routing features including the provisioning status of the subscription profile as claimed in Applicant's Claim 13.

At least for the foregoing reasons, Claim 13 is patentable over the disclosure of *Bright*. Applicant respectfully requests that the rejection of Claim 13 be withdrawn.

Under 35 U.S.C. § 103(a)

Claims 1-5, 8, 10 and 12 were rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0224811 to *Jain et al.* (hereinafter "*Jain*") in view of U.S. Patent Publication No. 2001/0002198 to *Lindgren et al.* (hereinafter "*Lindgren*"). Applicant respectfully traverses the rejection and requests reconsideration and withdrawal thereof.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. *See e.g., In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998); *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). *See* MPEP § 2142.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See* MPEP § 2143.02; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). It is

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settled that "the teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on the applicant's disclosure."

Applicant has amended independent Claim 1. Claim 8 has been cancelled. The cited references when combined fail to teach all of the limitations of the amended claims. Applicant respectfully submits that a prima facie case of obviousness has not been established which supports the rejection of these claims at least because the hypothetical combination does not include each of the features recited in Claim 1. Applicant also submits that there is no teaching or suggestion in the cited references for combining them in the manner set forth in the recent Office Action.

Amended Claim 1 is reproduced below:

Claim 1. A method, comprising the steps of:

migrating a communications device to a Global System for Mobile communications network, the communications device migrated from at least one of a Time Division Multiple Access communications network and a Code Division Multiple access communications network;

receiving an origination request from the communications device, the origination request for sending a message from the communications device, the origination request comprising *a network address of a message service center serving the communications device;*

receiving the message at a base station, the message proceeded by the origination request, forwarding the message to a mobile switching center and then to a Signaling Transfer Point, the Signaling Transfer Point associated with a signaling system 7 signaling point code;

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locating the message service center by associating the network address to the signaling system 7 signaling point code, the signaling point code identifying the message service center in the Global System for Mobile communications network;

replacing the network address of the origination request with the signaling point code;
and

routing the origination request and message to the message service center operating in the Global System for Mobile communications network, wherein the origination request is processed by the message service center.

Applicant respectfully submits that the hypothetical combination of *Jain* and *Lindgren* does not disclose at least the features of independent Claim 1 highlighted above. More specifically, for example, *Jain* and *Lindgren* fail to disclose, teach or include the many elements of receiving the message at a base station, the message proceeded by the origination request, forwarding the message to a mobile switching center and then to a Signaling Transfer Point, the Signaling Transfer Point associated with a signaling system 7 signaling point code and locating the message service center by associating the network address to the signaling system 7 signaling point code. The hypothetical combination of *Jain* and *Lindgren* also fails to disclose replacing the network address of the origination request with the signaling point code. Instead, the cited combination merely discloses routing messages by *identifying an IP message address, and transferring the message to that identified IP address*. The combination fails to describe, for example, *locating the message service center as discussed above and replacing the network address of the origination request with the signaling point code and routing the origination request and the message to the message service center operating in the GSM communications network*.

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The amendment is fully supported in the specification, for example, by paragraph [0017] to [0019] among others. Applicant respectfully submits that the rejection of Claim 1 under this section is improper as described above and requests that the rejection be withdrawn.

Claims 2-5, 10 and 12 depend from Claim 1, are allowable over the cited art for at least the same reasons as Claim 1. Applicant respectfully requests that the rejection of these claims be withdrawn.

CONCLUSION

For at least the above reasons, Applicant respectfully requests allowance of the claims pending in this case and issuance of a patent containing these claims in due course. Should Examiner Phan believe that a telephone conference would be useful to resolve any concerns and move this application to allowance, Examiner Phan is respectfully requested to contact the undersigned at the telephone number listed below. Otherwise, Applicant respectfully requests timely issuance of a Notice of Allowance for the present application.

Respectfully submitted,



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